



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/040,539	03/17/1998	AKIRA YOSHIDA	JA997028	1941

25696 7590 09/05/2002

OPPENHEIMER WOLFF & DONNELLY  
P. O. BOX 10356  
PALO ALTO, CA 94303

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 09/05/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

RD

**Notification of Non-Compliance with  
37 CFR 1.192(c)**

Application No.

09/040,539

Applicant(s)

Yoshida

Examiner

BA, HUYNH  
~~First Name~~

Art Unit

2173  
1204



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

The Appeal Brief filed on Nov 5, 2001 is defective for failure to comply with one or more provisions of 37 CFR 1.192(c). See MPEP § 1206.

To avoid dismissal of the appeal, applicant must file IN TRIPLICATE a complete new brief in compliance with 37 CFR 1.192(c) within the longest of any of the following three TIME PERIODS: (1) ONE MONTH or THIRTY DAYS from the mailing date of this Notification, whichever is longer; (2) TWO MONTHS from the date of the notice of appeal; or (3) within the period for reply to the action from which this appeal was taken. EXTENSIONS OF THESE TIME PERIODS MAY BE GRANTED UNDER 37 CFR 1.136.

1. ☐ The brief does not contain the items required under 37 CFR 1.192(c), or the items are not under the proper heading or in the proper order.
2. ☐ The brief does not contain a statement of the status of all claims, pending or cancelled, or does not identify the appealed claims (37 CFR 1.192(c)(3)).
3. ☐ At least one amendment has been filed subsequent to the final rejection, and the brief does not contain a statement of the status of each such amendment (37 CFR 1.192(c)(4)).
4. ☐ The brief does not contain a concise explanation of the claimed invention, referring to the specification by page and line number and to the drawing, if any, by reference characters (37 CFR 1.192(c)(5)).
5. ☐ The brief does not contain a concise statement of the issues presented for review (37 CFR 1.192(c)(6)).
6. ☐ A single ground of rejection has been applied to two or more claims in this application, and
  - (a) ☐ the brief omits the statement required by 37 CFR 1.192(c)(7) that one or more claims do not stand or fall together, yet presents arguments in support thereof in the argument section of the brief.
  - (b) ☐ the brief includes the statement required by 37 CFR 1.192(c)(7) that one or more claims do not stand or fall together, yet does not present arguments in support thereof in the argument section of the brief.
7. ☐ The brief does not present an argument under a separate heading for each issue on appeal (37 CFR 1.192(c)(8)).
8. ☒ The brief does not contain a correct copy of the appealed claims as an appendix thereto (37 CFR 1.192(c)(9)).
9. ☒ Other (including any explanation in support of the above items):

*The Reply brief filed on 5/31/02 have been carefully considered and entered into the record. See paper attached.*

BA HUYNH  
PRIMARY EXAMINER

Art Unit:

### DETAILED ACTION

1. The applicant is hereby notified that the Appeal Brief filed on 11/05/01 is defected because the copy of claims in the appendix fails to present the claims on appeal. Claims on appeal are those presented with the latest amendment, filed on 1/22/01 (paper #18). Attention is brought to claim 1, line 8 and claim 2, line 10 (of the appendix), wherein the phrase "said display indicating frame and" must be deleted as indicated in the 1/22/01 amendment. Correction is required. To avoid dismissal of the appeal, correction must be submit within ONE MONTH or 30 DAYS from the mailing of this communication, which ever is longer.

2. The Reply brief filed on 5/31/02 have been considered and entered into the record.

#### REMARKS:

In response to appellant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). As set forth in previous communications, Middlebrook substantially teach the claimed invention, except the "display indicating frame". However, the deficiency is disclosed in the combined Tran's teaching of selection frame 106". In light of the combination, the cursor 48 is replaced by "display indicating

Art Unit:

frame" 106", which are moved responsive to movement of the mouse. See Middlebrook, col. 4, lines 5-16.

The appellant further argues that the combined teachings do not teach the dragging of the display indicating frame from a first sub-screen to a second sub-screen with a pointing device. The appellant's argument comprises two issues: a) the combined teachings do not teach that the display indicating frame being dragged by a pointing device, and b) the dragging is from the first sub-screen to the second sub-screen. As for dragging of the display indicating frame, attention is brought to the exact claim languages "moving said image data within said main screen in correspondence to an output representing movement of a pointing device" (claim 1, lines 8-9) and "causing said display indicating frame to be moved within said sub-screen while said pointing device is in dragging state" (claim 1, lines 10-12). The claim language clearly recite the movement of the pointing device (i.e., the mouse) which cause corresponding movement of the indicating frame. This is similar to the well known movement of the mouse causing corresponding movement of the cursor. It should be further noted that moving a mouse is dragging the mouse from a first position to a second position while the mouse is continuously contact with the surface of the mouse pad. Conventionally, "dragging" (of a graphic object) refers to the depressing of a mouse button while the cursor is overlaying the graphic object, and moving the object by moving the mouse. This definition of conventional dragging is not what the appellant recited in the claim. In the appellant's claim, movement of the mouse causes corresponding movement of the display indicating frame, just like the cursor. Middlebrook

Art Unit:

clearly teaches this feature in col. 4, lines 5-16), wherein the position icon 48 is moved to different display areas in map window 34 (figure 3) or to different sub-windows of window 300 (figure 7), corresponding to movement of the mouse (Middlebrook's col. 3, lines 58-67; col. 4, lines 5-16). Movement of the selection frame 106" (display indicating frame) corresponding to movement of the mouse is also disclosed by Tran in col. 12, lines 15-20, and in figure 2B. In response to the argument that the combined teaching do not teach the dragging from a first sub-screen to a second sub-screen, attention is brought to Middlebrook's teaching of dragging the position icon 48 to different display area within map window 34 (col. 4, lines 5-16) or to different sub-screen of the map window 300 (col. 9, lines 58-62). In light of the combining, replacing Middlebrook's position icon 48 by Tran's selection frame 106", the selection frame 106" can be moved around in a similar manner as with the position icon 48.

For the reasons as set forth above and in the examiner answer, it is believed that the rejection should be sustained.

### **Inquires**

Responses to this action should be mailed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231. If applicant desires to fax a response, (703) 746-7238 may be used for formal After Final communications, (703) 746-7239 for Official communications, or (703) 746-7240 for Non-Official or draft communications. NOTE: A Request for Continuation (Rule 60 or 62) cannot be faxed.

Art Unit:

Please label "PROPOSED" or "DRAFT" for informal facsimile communications. For after final responses, please label "AFTER FINAL" or "EXPEDITED PROCEDURE" on the document.

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

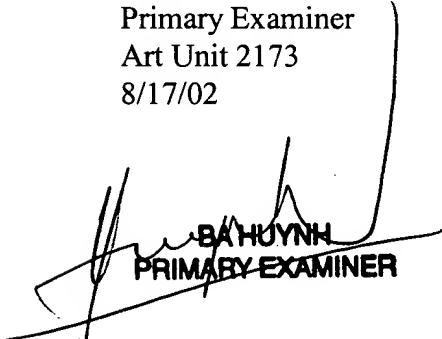
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huynh-Ba whose telephone number is (703) 305-9794. The examiner can normally be reached on Monday-Friday from 8.00AM to 4.30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca, can be reached on (703) 308-3116.

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3800.

Huynh-Ba  
Primary Examiner  
Art Unit 2173  
8/17/02

  
BA HUYNH  
PRIMARY EXAMINER